

REMARKS / ARGUMENTS

In response to the Office Action mailed April 19, 2006, the Examiner's claim rejections have been considered. Applicants respectfully traverse all rejections regarding all pending claims and earnestly solicit allowance of these claims.

1. Interview

Applicants sincerely appreciate the courtesies extended by Examiner Omar Flores Sanchez and Primary Examiner Kenneth Peterson during a telephonic interview conducted on October 8, 2002. During the interview, Applicants presented amendments to claims 22 and 30 that clarify how the strip of media can be in a fixed position relative to the tear bar, when it is in the process of separation. Examiners indicated that the amendments to claims 22 and 30 would overcome the 35 U.S.C. §112 rejection.

Applicants further presented distinctions between claims 22 and 30 and Saito *et al.* Examiners agreed that Saito et al. does not disclose a tear bar being in a fixed position during the separation of the strip of media. Examiners indicated they would withdraw the 35 U.S.C. § 102(b) in view of Saito et al.

Next, Examiners indicated that the application would be placed in condition for allowance if claims 22 and 30 were amended to include language regarding the height of different portions of the tear bar relative to each other. Applicants have amended claims 22 and 30 by this Amendment to incorporate language that Applicants believe achieve the examiner's objective. Applicants request allowance of claims 22 and 30 and their dependent claims.

2. Claim Rejections – 35 U.S.C. § 112

The Examiner rejected claims 22 and 30 and their dependent claims under 35 USC §112.

Applicants amended claims 22 and 30 to clarify how the strip of media can be in a fixed position relative to the tear bar, when it is in the process of separation. Applicants submit that amended claims 22 and 30 comply with the requirements of 35 U.S.C. §112. Examiners also indicated that the amendments to claims 22 and 30 (shown above) would overcome the 35

U.S.C. §112 rejection. Applicants respectfully request withdrawal of 35 U.S.C. §112 rejection on claims 22 and 30 and their dependent claims.

3. Claim Rejection – 35 U.S.C. § 102

The Examiner rejected claims 22, 23, 26, 28, 29, and 30-33 under 35 U.S.C. § 102(b) in view of Saito *et al.*

Applicants submit that claims 22, 23, 26, 28, 29, and 30-33 are not anticipated by Saito et al. As stated by the Federal Circuit: Anticipation requires the presence in a single prior art reference disclosure of each and every element of the claimed invention, arranged as in the claim. Lindermann Maschinenfabrik GMBH v. American Hoist and Derrick Co., 221 USPQ 481, 485 (Fed. Cir. 1984).

Claims 22 and 30 claims a tear bar remaining in a fixed position during the separation of the strip of media. On the other hand, Saito et al. appears to disclose a tear bar moving in upward and downward direction (i.e. bursting action) to separate the strip of media. Saito et al. therefore does not disclose each and every element of the claimed invention. Applicants request withdrawal of the 35 U.S.C. §102(b) rejection of claims 22 and 30. Applicants also request withdrawal of the 35 U.S.C. §102(b) rejection of claims 23, 26, 28, and 29, as they are dependent on claim 22 and incorporate the tear bar feature of claim 22. Applicants further request withdrawal of the 35 U.S.C. § 102(b) rejection of claims 31-33, as they are dependent on claim 30 and incorporate the tear bar feature of claim 30.

4. Claim Rejections – 35 U.S.C. § 103(a)

The Examiner rejected claims 22-34 under 35 U.S.C. § 103(a) as being unpatentable over Michalovic in view of Ishii *et al.*

Applicants respectfully submit that claims 22-34 are patentable over Michalovic in view of Ishii et al. for the following reasons.

The cited references, even when improperly combined, do not teach or suggest all the claim limitations.

MPEP §2143 states that the prior art reference or references when combined must also teach or suggest all the claim limitations. See also *In re Royka*, 490 F.2d 981. Notwithstanding Applicants' arguments against improper combination of references, Applicants submit that even if the cited references were combined, the cited references do not teach or suggest all the claim limitations.

For example, claims 22 and 30 claims a tear bar having a feature wherein no portion of the tear bar between the first and second side portions is closer to the strip of media than the first side portion. The tear bar in Michalovic appears to have a uniform diameter. See also Figure 2 of Michalovic. With regard to Ishii et al. and with reference to figure 1 of Ishii et al., the tear bar in Ishii et al. appears to have tear bar portions between side portions, which are closer to the media than the side portions (see portions between reference numbers 360 (first occurrence, left side of figure 1) and 310 and portions between 310 and 360 (second occurrence, right side of figure 1)).

In sum, Michalovic and Ishii et al. do not disclose each and every element of claims 22 and 30. By virtue of their claim dependency to claims 22 and 30, Michalovic and Ishii et al. also do not disclose each and every element of dependent claims 23-29 and 31-34, respectively. Applicants respectfully request withdrawal of 35 USC 103(a) rejection on claims 22-34.

The combination of Michalovic and Ishii et al. is improper.

To establish a prima facie case of obviousness, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art to modify the reference or to combine reference teachings. MPEP §2143, See also *In re Rouffet*, 149 F.3d 1350, 1357. The applicant submits that the Office has not established a prima facie case of obviousness because there is no suggestion or motivation to combine Michalovic and Ishii et al. as discussed below.

Michalovic teaches using a tear surface having a uniform diameter, whereas Ishii et al. teaches using a tear surface having varying diameters.

Michalovic appears to be an apparatus for dispensing linerless labels with adhesives. As such, Michalovic states that sticking of labels to dispensing apparatus components is a significant problem. See column 1, lines 28-34. If the dispensing apparatus has a tear surface of varying

diameter, the labels have more tendency to stick to the uneven tear surface than a dispensing apparatus with uniform tear surface, making it difficult and expensive to dispense labels.

Ishii et al., on the other hand, appears to provide an apparatus for issuing a ticket with a cutting roller that creates diamond-shaped openings in the center of the perforations on media. The diamond-shaped openings are specifically created by a plurality of edges having variable diameters on the axle of the roller.

Additionally, Michalovic states "where blades or like components are used as a force concentrating structure to facilitate tearing of labels along the perforation lines, the concentrating structures must be cleaned often to prevent build up of adhesive." Column 1, lines 33-37. Thus, Michalovic teaches away from using blades or like components.

Ishii et al., on the other hand, appears to teach the use of cutting roller, which is a form of a force concentrating structure, to create diamond-shaped openings in the center of the perforations on media. The diamond-shaped openings allow Ishii et al. to attain the objects of their invention, as the diamond-shaped openings generated by the cutting roller allow tickets to be cut clearly without leaving any scraps, which may cause an apparatus to jam and may cause a customer to question the authenticity of a ticket. The objects of Ishii et al.'s invention are to prevent apparatus from jamming and to provide a high quality ticket cut with precision from a ticket sheet. See column 2, lines 4-9.

In sum, there is no suggestion or motivation, either in Ishii et al. or in Michalovic or in the knowledge generally available to one of ordinary skill in the art to modify or to combine reference teachings of Ishii et al. and Michalovic. Michalovic teaches away from being modified with numerous aspects of Ishii et al.'s tear bar, and vice-versa. Withdrawal of 35 U.S.C. 103(a) rejections based on the combination of Ishii et al. and Michalovic is respectfully requested.

The amendments to the claims above have not been made to overcome patentability rejections. Applicants make certain amendments to correct typographical errors, to clarify the readability of the claims for the examiner, and to obtain an early allowance of the application. Applicants believe the original claims are patentable over the cited reference.

CONCLUSION

Applicants have made an earnest and *bona fide* effort to clarify the issues before the Examiner and to place this case in condition for allowance. Reconsideration and allowance of all of claims 22-34 is believed to be in order, and a timely Notice of Allowance to this effect is respectfully requested.

The Commissioner is hereby authorized to charge any additional required fees from Deposit Account No. 502811, Deposit Account Name BROWN RAYSMAN MILLSTEIN FELDER & STEINER LLP.

Should the Examiner have any questions concerning the foregoing, the Examiner is invited to telephone the undersigned attorney at (310) 712-8300. The undersigned attorney can normally be reached Monday through Friday from about 9:00 AM to 6:00 PM Pacific Time.

Respectfully submitted,

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